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September 29, 2005

Date

Deborah A. Rypacek

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Polonsky *et al.*

Serial No.: 09/768,877

Filed: January 23, 2001

For: METHODS OF TREATMENT OF TYPE 2
DIABETES

Appeal No.: 2005-0258

Group Art Unit: 1652

Examiner: Ramirez, Delia M.

Atty. Dkt. No.: ARCD:307USD1

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
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REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §41.52

Applicants, Kenneth S. Polonsky, Yukio Horikawa, Naohisa Oda, Nancy J. Cox, Craig L. Hanis, and Graeme I. Bell, submit this Request for Rehearing Pursuant to 37 C.F.R. §41.52, following the decision of the Board of Patent Appeals and Interferences dated July 29, 2005. This request is filed within two months of the decision, and accordingly, is timely filed. It is believed that no fee is due; however, should any fees be required for any reason, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/ARCD:307USD1. Favorable consideration of this request is respectfully requested.

REMARKS

I. Summary of the Argument

As will be discussed in further detail below, Appellants request this hearing because the Board erroneously determined that Appellants had not complied with 37 C.F.R. 1.192(c)(7)(2002). The Board overlooked Appellants' arguments related to the patentability of claims 19 and 53 separate from claims 18, 20, 21, 49, 50, 51, 52, 54, 55, 57-64, 115 and 116 (Appellants' Brief page 13).

II. Board Decision

The Decision on Appeal mailed July 29, 2005 ("Board Decision") (i) reversed the rejection of claims 18-21, 49-51, 53-64, 115 and 116 under 35 U.S.C. § 112, second paragraph, as being indefinite in the recitation of the term "calpain 10"; (ii) reversed the rejection of claims 19, 49 and 53 under 35 U.S.C. § 112, first paragraph as failing to adequately describe the claimed invention; (iii) affirmed the rejection of claims 18-21, 49-51, 53-64, 115 and 116 under 35 U.S.C. § 112, first paragraph as failing to adequately describe the claimed invention; and (iv) did not reach the merits of the rejection of claims 18-21, 49-51, 53-64, 115 and 116 under 35 U.S.C. § 112, first paragraph as failing to provide sufficient disclosure to support or enable the scope of the claimed invention.

With respect to the Board's affirmation of the rejection of claims 18-21, 49-51, 53-64, 115 and 116 under 35 U.S.C. §112, first paragraph written description requirement, claim 51 was determined to be representative of both claim group 18, 20, 21, 49, 50, 51, 52, 54, 55, 57-64, 115 and 116 (group I), and claim group 19 and 53 (group II). Board Decision at page 7. Claims 18-21, 49-51, and 53-64 were considered to stand or fall together for alleged lack of argument under

C.F.R. 1.192(c)(7)(2002). Specifically, representative claim 51 was found to lack written description because the Board agreed with the Examiner's contention that the specification does not describe the genus of calpain 10 polypeptides by describing a "representative number" of calpain 10 polypeptides. Board Decision at page 15. Consequently, claims 19 and 53 were also found to lack written description because the Board had determined that claims 19 and 53 did not stand or fall separately from claim 51.

III. Argument

Argument for the Separate Patentability of Claims 19 and 53 under 37 C.F.R. 1.192(c)(7) (2002) Is Provided in the Appellants' Brief.

The Board alleges that Appellants have failed to separately argue the patentability of claims 19 and 53 relative to rejected claims 18-21, 49-51, 53-64, 115 and 116 for lack of written description under 35 U.S.C. § 112, first paragraph. Appellants respectfully disagree. Appellants direct the Board to page 13 of Appellants' Brief where claims 19 and 53 are specifically argued as satisfying the written description requirement as contrasted to pages 14-17 of Appellants' Brief where claims 18-21, 49-51 and 53-64 are argued generally. The rule relied upon by the Board is 37 C.F.R. 1.192(c)(7)(2002) that states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the group for rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under (c)(8) of this section, appellant explains why the claims of the group believed to be separately patentable...

Appellants argue in their Brief that the further limitation to a calpain 10 comprising "amino acids 1-47 of SEQ ID NO:2" present in claims 19 and 53 describes species of calpain 10 specifically described in the specification. Amino acids 1-47 of SEQ ID NO:2, human calpain 10, is described in the specification in such a way as to reasonably convey to one of skill in the art that

the inventors, at the time the application was filed, had possession of the claimed invention. In fact, the Board's Decision on page 11 concedes this fact stating:

We recognize that there is not dispute on this record that appellants have disclosed a "full length" human calpain 10 polypeptide and various human calpain 10 isomers.

Appellants have both stated that claims 19 and 53 do not stand or fall with claims 18, 20, 21, 49, 50, 51, 52, 54, 55, 57-64, 115 and 116 (Appellants' Brief page 7) and have argued the patentability, in particular the satisfaction of the written description requirement, of claims 19 and 53 separately as required by 37 C.F.R. 1.192(c)(7) (2002) (Appellants' Brief page 13). Appellants requested that claims 19 and 53 be considered separately from claim 51 and they respectfully urge that this request be fulfilled.

Rehearing on the issue of written description relative to claims 19 and 53 is requested in light of the Board's oversight of the argument provided on page 13 of Appellants' Brief and the use of representative claim 51 to determine the patentability of claims 19 and 53 under 35 U.S.C. §112, first paragraph written description requirement.

IV. Conclusion

Appellants believe the foregoing arguments indicate rehearing in this case is proper. Moreover, Appellants reserve the right to appeal the Board's Decision on Appeal mailed July 29, 2005 to the Federal Circuit under 35 U.S.C. § 141.

Dated: September 29, 2005

Respectfully submitted,

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